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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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22506	7590	05/12/2006	EXAMINER REIDEL, JESSICA L	
JAGTIANI + GUTTAG 10363-A DEMOCRACY LANE FAIRFAX, VA 22030			ART UNIT 3766	PAPER NUMBER

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/070,102	Applicant(s) DADD ET AL.	
	Examiner Jessica L. Reidel	Art Unit 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-6 and 8-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 is/are allowed.
- 6) ☒ Claim(s) 2, 4-6, 8-10, 13-18 and 20-29 is/are rejected.
- 7) ☒ Claim(s) 11,12 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Acknowledgement is made of Applicant's Amendment, received by the Office on March 14, 2006. Claims 1, 3 and 7 have been cancelled. Claims 2, 4-6 and 8-31 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 2, 4-6, 8-10, 15-18 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Treaba et al. (U.s. 6,421,569) (herein Treaba).

The applied reference has common Inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

4. As to Claims 2 and 21, Treaba discloses a cochlear implantable electrode array, read as a cochlear implant electrode assembly device 10 (see Treaba Abstract and Fig. 1a) comprising an elongate electrode carrier member 12 having a plurality of electrodes 32 (see Treaba Figs. 1a-1b and 2a-2b, column 2, lines 50-52, column 4, lines 1-2 and lines 19-21) having a first, substantially straight configuration selected to allow the member 12 to be inserted into an

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implantee's cochlea and a second, curved configuration to conform to the surface of the cochlea of a patient (see Treaba column 2, lines 35-65). The elongate electrode carrier member 12 of Treaba is made from a plastic material, such as medical grade silicone rubber, which is inherently a resiliently flexible first material (see Treaba Abstract, and column 4, lines 4-6).

Treaba expressly discloses in the abstract, lines 4-5 that "The array can be straightened, and held in a straight configuration by inserting a stylet into the lumen" and at column 2, lines 59-64 Treaba expressly discloses that,

Prior to insertion of the carrier into the cochlea, the stylet is introduced into the carrier to insure that the carrier is maintained in a substantially straight configuration. As the array is inserted into the cochlea, the stylet is slowly withdrawn allowing the array to assume a curved configuration (see Treaba column 2, lines 59-67).

Treaba further discloses that lumen 30 of the elongate member 12 may receive first and second stiffening stylets, read as first and second stiffening elements 44-1 and 44-2 (see Treaba column 8, lines 53-56), and that the second stiffening element 44-2 may only extend partially along the length of device 10, i.e. may be shorter than the first stiffening element 44-1 (see Treaba column 8, lines 55-56). It is inherent that when the lumen 30 contains two stiffening elements 44-1 and 44-2, the stylets in combination, bias the pre-curved electrode assembly device 10 into the first, relatively straight configuration and then upon removal of either styles 44 from the elongate member 12, the array assumes a second curved configuration (see Treaba Figs. 7a-7d and 8a and 8b, column 2, lines 57-64, column 3, lines 14-22 and column 7, lines 36-39 and lines 65-67). The Examiner takes the position that removal of the shorter stiffening element 44-2 will not cause the entire elongate carrier member 12 to fully adopt to the second fully curved configuration that occurs with complete removal of the longer stiffening element 44-1 (see

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Treaba column 8, lines 4-6). The Examiner also takes the position that the elongate carrier does not instantaneously or immediately change from a first straight configuration to a second fully curved configuration upon removal of either of the stiffening elements 44 and it is inherent that the elongate member 12 assumes an intermediate partially curved configuration between the first and second configurations, especially when a shorter second stiffening element 44-2 is used and removed first.

5. As to Claim 4, Treaba discloses that the elongate electrode carrier member 12, when in the second curved configuration, adopts a spiral configuration 16 (see Treaba Fig. 1b and column 3, lines 65-67).

6. As to Claim 5, Treaba discloses that the elongate member 12 is preformed to the second, curved configuration and made of a plastic material such as medical grade silicone rubber (see Treaba column 4, lines 4-6). It is inherent that the plastic material that comprises the elongate member 12 also comprises memory capabilities because a straightening jig is necessary to insert the stiffening elements 44 which hold the member 12 straight and when the stiffening elements 44 are removed the elongate member re-assumes the pre-curved configuration (see Treaba column 3, lines 14-22 and Figs. 7a-7d).

7. As to Claim 6, Treaba discloses that the elongate electrode carrier member 12 has a first distal end or tip 10a that is firstly inserted into the implantee and that extends forwardly from the first end of the elongate member 12 (see Treaba Figs. 2a and 7a-7d and column 7, lines 24-27).

8. As to Claim 8, the elongate electrode carrier member 12 of Treaba is made from a plastic material, such as medical grade silicone rubber, which is inherently biocompatible (see Treaba Abstract, and column 4, lines 4-6).

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9. As to Claims 9 and 15-17, Treaba discloses that the stiffening elements 44-1 and 44-2 are made from non-bioresorbable platinum stylet (see Treaba column 6, lines 8-15 and column 9, lines 30-34).
10. As to Claim 10, Treaba discloses that the stylet 44 is stiffer and more rigid than the first material of the carrier 12 (see Treaba column 3, lines 19-22).
11. As to Claim 18, Treaba further discloses that a single lumen 30 of the elongate member 12 may receive first and second stiffening stylets, read as first and second stiffening elements 44-1 and 44-2 (see Treaba column 8, lines 53-56).
12. As to Claim 29, it is inherent from the entire distal portion of elongate carrier 12's ability to assume a gradual increase in curvature (see Treaba Figs. 7a-7d) that the distal end or tip 10a is flexible.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 13-14, 22-25 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treaba in view of Parker et al. (U.S. 5,653,742). As to Claims 13-14 and 22-23, Treaba discloses the claimed invention as discussed above except that neither stiffening elements 44-1 or 44-2 are disclosed expressly to be formed of a bioresorbable material, which dissolves or softens upon exposure to body fluid, selected from the group comprising polyacrylic acid (PAA), polyvinyl alcohol (PVA), polylactic acid (PLA) and polyglycolic acid (PGA).

Parker, however, discloses cochlear electrode array, read as an implantable tissue-stimulating device 20 comprising an elongate carrier member 12, made of a resiliently flexible elastic material, having a plurality of electrodes 16 mounted on the elongate carrier member 12. Parker also discloses that the device 20 comprises a stiffening element 18 that biases elongate member 12 into an insertion configuration, read as a first configuration allowing the member to be inserted into an implantee's body. Upon removal of the stiffening element 18 from the elongate member 12 the elongate member adopts a deployed configuration, read as a second curved configuration where the elongate member is adapted to apply preselected tissue stimulation with the electrodes 16 (see Parker Abstract, Figures 1 and 2, column 3, lines 30-35 and lines 53-67 and column 4, lines 1-4). Parker further discloses that the elongate member 12 is preformed from a plastics material with memory and is preformed to the second curved configuration (see Parker column 3, lines 23-30).

Parker further discloses that the stiffening element 18 is made of a bioresorbable material, which dissolves or softens up on insertion into a cochlea, and may be made of polyvinyl alcohol (PVA), polylactic acid (PLA), polyglycolic acid (PGA) and other similar compounds (see Parker Abstract, column 2, lines 35-37 and column 3, lines 38-41). Parker does not explicitly state why the bioresorbable material is used, but it appears that a bioresorbable-stiffening element is used to provide increasing flexibility of the elongate member the member is inserted into the body, such as the cochlea. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the either stiffening element as taught by Treaba, with a bioresorbable-stiffening element made of polyvinyl alcohol (PVA), polylactic acid (PLA), polyglycolic acid (PGA) and other similar compounds, as taught by Parker, since such a

modification would provide the device with a bioresorbable-stiffening element for providing increasing flexibility of the elongate member upon insertion of the member into the cochlea.

15. As to Claims 24 and 25, Treaba discloses the claimed invention as discussed above except that the device does not include an additional layer surrounding the elongate member, the additional layer having a first rate of fluid ingress therethrough and having at least one fluid ingress means formed therein, the rate of fluid ingress through the fluid ingress means being greater than the first rate of fluid ingress through the additional layer and wherein the fluid ingress means comprises one or more slits in the additional layer.

Parker, however, discloses cochlear electrode array, read as an implantable tissue-stimulating device 20 comprising an elongate carrier member 12, made of a resiliently flexible elastic material, having a plurality of electrodes 16 mounted on the elongate carrier member 12. Parker also discloses that the device 20 comprises a stiffening element 18 that biases elongate member 12 into an insertion configuration, read as a first configuration allowing the member to be inserted into an implantee's body. Upon removal of the stiffening element 18 from the elongate member 12 the elongate member adopts a deployed configuration, read as a second curved configuration where the elongate member is adapted to apply preselected tissue stimulation with the electrodes 16 (see Parker Abstract, Figures 1 and 2, column 3, lines 30-35 and lines 53-67 and column 4, lines 1-4). Parker further discloses that the elongate member 12 is preformed from a plastics material with memory and is preformed to the second curved configuration (see Parker column 3, lines 23-30).

Parker further discloses in Fig. 5 an alternate embodiment of the device comprising an additional layer which has a first rate of fluid ingress therethrough and has at least one fluid

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ingress means formed therein 19', the rate of fluid ingress through the fluid ingress means being greater than the first rate of fluid ingress through the additional layer. The fluid ingress means comprises one or more dimples, read as slits 17' in the additional layer of the elongated member 12. Parker also discloses that the purpose of the slits is to hold a stiffener material 19'. The stiffener 19' material of Parker is introduced into the slits 17' only after the carrier 10' is deformed to assume a straight or linear configuration, as seen in FIG. 5. The material is the same material as the material of sheath 18, that is, it is bioresorbable. In the embodiment of FIG. 5, the material 19' provides rigidity to the carrier 10' to prevent the carrier 10' from taking its spiral shape. In this manner, the carrier 10' can be readily implanted into the scala tympani. After implantation, the material 19' dissolves in the cochlear fluid and allows the carrier 10' to move back to its spiral shape (see Parker Fig. 5 and column 4, lines 5-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Treaba in view of Parker to include an additional layer surrounding the elongate member, the additional layer having a first rate of fluid ingress therethrough and having at least one fluid ingress means formed therein, the rate of fluid ingress through the fluid ingress means being greater than the first rate of fluid ingress through the additional layer and wherein the fluid ingress means comprises one or more slits in the additional layer to further hold the elongate member in a relatively straight configuration so that it may be implanted into the scala tympani.

16. As to Claim 27, Treaba discloses the claimed invention as discussed above except that at least a portion of the outer surface of the elongate member is disclosed to be coated with a lubricious material.

Parker, however, discloses cochlear electrode array, read as an implantable tissue-stimulating device 20 comprising an elongate carrier member 12, made of a resiliently flexible elastic material, having a plurality of electrodes 16 mounted on the elongate carrier member 12. Parker also discloses that the device 20 comprises a stiffening element 18 that biases elongate member 12 into an insertion configuration, read as a first configuration allowing the member to be inserted into an implantee's body. Upon removal of the stiffening element 18 from the elongate member 12 the elongate member adopts a deployed configuration, read as a second curved configuration where the elongate member is adapted to apply preselected tissue stimulation with the electrodes 16 (see Parker Abstract, Figures 1 and 2, column 3, lines 30-35 and lines 53-67 and column 4, lines 1-4). Parker further discloses that the elongate member 12 is preformed from a plastics material with memory and is preformed to the second curved configuration (see Parker column 3, lines 23-30).

Parker further discloses an implantable tissue-stimulating device wherein at least a portion of an outer surface of the elongate member 12, surrounded by stiffening element 18, has a coating of a lubricious material to reduce friction and also may be made of a time-released antimicrobial material to provide protection against infections during implantation (see Parker column 3, lines 40-48). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the elongate member of Treaba in view of Parker to be coated with a lubricious material to reduce provide protection against infections during implantation.

17. As to Claim 28, the previously modified Treaba reference discloses the claimed invention as discussed above except the lubricous material is not disclosed to be selected from the group

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comprising polyacrylic acid (PAA), polyvinyl alcohol (PVA), polylactic acid (PLA) and polyglycolic acid (PGA). It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the lubricous material from the group comprising polyacrylic acid (PAA), polyvinyl alcohol (PVA), polylactic acid (PLA) and polyglycolic acid (PGA), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

18. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Treaba in view of Kuzma (U.S. 6,119,044). Treaba discloses the claimed invention as discussed above except that neither the first 44-1 or second 44-2 stiffening elements are disclosed as being formed from a shape memory material.

Kuzma, however, discloses an implantable electrode array 10 including a flexible carrier body 13 having a channel 11 (see Kuzma column 7, lines 16-20) for receiving a positioning stylet 20 made from a memory wire that assumes a relatively straight, or non-spiral shape for insertion purposes and curves to fit the cochlea wall after insertion (see Kuzma column 7, lines 35-50). The memory wire assumes or returns to the desired curvature needed to place the electrodes of the array against the modiolar wall so that the curvature wraps as snugly as possible around the modiolus of the cochlea in order to make the best electrode contact with the implantee (see Kuzma column 3, lines 35-40 and lines 60-64 and column 4, lines 21-29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify either stiffening element of Treaba in view of Kuzma with shape memory stiffening stylet in order to facilitate bending of the array with the electrodes on the inside of the

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bend to place the electrodes of the array against the modiolar wall so that the curvature wraps as snugly as possible around the modiolus of the cochlea in order to make the best electrode contact with the implantee.

19. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Treaba in view of Parker and Kuzma. Treaba discloses the claimed invention as discussed above except that neither the first 44-1 or second 44-2 stiffening elements are disclosed as being formed from a bioresorbable material, which dissolves or softens upon exposure to body fluid.

Parker, however, discloses cochlear electrode array, read as an implantable tissue-stimulating device 20 comprising an elongate carrier member 12, made of a resiliently flexible elastic material, having a plurality of electrodes 16 mounted on the elongate carrier member 12. Parker also discloses that the device 20 comprises a stiffening element 18 that biases elongate member 12 into an insertion configuration, read as a first configuration allowing the member to be inserted into an implantee's body. Upon removal of the stiffening element 18 from the elongate member 12 the elongate member adopts a deployed configuration, read as a second curved configuration where the elongate member is adapted to apply preselected tissue stimulation with the electrodes 16 (see Parker Abstract, Figures 1 and 2, column 3, lines 30-35 and lines 53-67 and column 4, lines 1-4). Parker further discloses that the elongate member 12 is preformed from a plastics material with memory and is preformed to the second curved configuration (see Parker column 3, lines 23-30).

Parker further discloses that the stiffening element 18 is made of a bioresorbable material, which dissolves or softens up on insertion into a cochlea, and may be made of polyvinyl alcohol (PVA), polylactic acid (PLA), polyglycolic acid (PGA) and other similar compounds (see Parker

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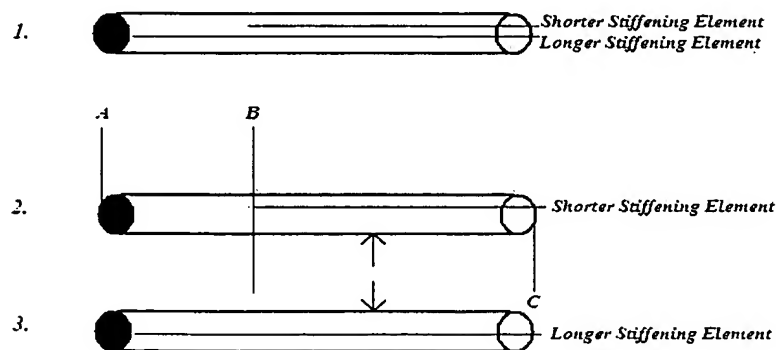
Abstract, column 2, lines 35-37 and column 3, lines 38-41). Parker does not explicitly state why the bioresorbable material is used, but it appears that a bioresorbable-stiffening element is used to provide increasing flexibility of the elongate member the member is inserted into the body, such as the cochlea. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the either stiffening element as taught by Treaba, with a bioresorbable-stiffening element made of polyvinyl alcohol (PVA), polylactic acid (PLA), polyglycolic acid (PGA) and other similar compounds, as taught by Parker, since such a modification would provide the device with a bioresorbable-stiffening element for providing increasing flexibility of the elongate member upon insertion of the member into the cochlea.

The previously modified Treaba reference discloses the claimed invention as discussed above except that neither the first 44-1 or second 44-2 stiffening elements are disclosed as being formed from a shape memory material. Kuzma, however, discloses an implantable electrode array 10 including a flexible carrier body 13 having a channel 11 (see Kuzma column 7, lines 16-20) for receiving a positioning stylet 20 made from a memory wire that assumes a relatively straight, or non-spiral shape for insertion purposes and curves to fit the cochlea wall after insertion (see Kuzma column 7, lines 35-50). The memory wire assumes or returns to the desired curvature needed to place the electrodes of the array against the modiolar wall so that the curvature wraps as snugly as possible around the modiolus of the cochlea in order to make the best electrode contact with the implantee (see Kuzma column 3, lines 35-40 and lines 60-64 and column 4, lines 21-29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify either stiffening element of Treaba in view of Kuzma with shape memory stiffening stylet in order to facilitate bending of the array with the

electrodes on the inside of the bend to place the electrodes of the array against the modiolar wall so that the curvature wraps as snugly as possible around the modiolus of the cochlea in order to make the best electrode contact with the implantee.

Response to Arguments

20. Applicant's arguments filed March 14, 2006 have been fully considered but they are not persuasive. First, in response to Applicant's Argument that "Treaba fails to provide any evidence to support that removal of the shorter stiffening element 44-2 will not cause the entire elongate carrier member 12 to fully adopt to the second fully curved configuration" (see page 8 of the Remarks), the Examiner acknowledges that although Treaba is silent to such, it is *inherent* that if either the first stiffening element or the second stiffening element 44-1, 44-2 is removed from the elongate member 12, the elongate member adopts *a one partially curved intermediate configuration* [Emphasis Added]. The Examiner wishes to clarify the inherency argument via the following diagram and explanation.



The diagram above illustrates the three possible situations of the cochlear implant electrode assembly device 10 of Treaba. In the first situation, the elongate member 12 is shown as held in a substantially straight configuration by inserting two stylets into the lumen (with one

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stylet being shorter than the other) as stated by Treaba in the abstract, lines 4-5, at column 2, lines 59-64 and column 8, lines 53-56. In the second situation, when the longer stiffening element is removed from the carrier, the section of the carrier between lines A and B is inherently allowed to curve both horizontally and vertically back to its pre-molded shape. Also the empty lumen, or the portion of the carrier where the longer stiffening stylet used to reside within the lumen, is allowed to partially curve upwards towards the shorter stylet as indicated by the arrow. The section of the carrier between line B and C (where the shorter stylet is still in place) inherently remains held horizontally straight, thus the carrier adopts a partially curved intermediate configuration when the longer stiffening stylet is removed. As to the third situation when the shorter stiffening element is removed, the empty lumen, or the portion of the carrier where the shorter stiffening stylet used to reside within the lumen, is allowed to partially curve downwards towards the longer stylet as indicated by the arrow, thus the carrier adopts a partially curved intermediate configuration when the shorter stiffening stylet is removed. When both the stiffening stylets are removed the entire length of the carrier is inherently allowed to fully curve (i.e. both horizontally and vertically) to adopt a fully curved second configuration. Although Treaba is silent to the three configurations when discussed the embodiment of two stiffening elements 44-1 and 44-2, what happens to the pre-curved carrier is *inherent*.

21. As to Applicant's Argument that Treaba teaches away from the claimed invention (see page 8-9 of the Remarks) the Examiner respectfully disagrees. Treaba specifically states at column 7, lines 61-63 that the carrier 12 "has a lumen 30 which allows a surgical stylet 44 to be inserted to hold the array straight for insertion". Applicant does agree, that as a physician inserts the carrier 12 in a patient's cochlea, contact made with the wall of the cochlea will allow the

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flexible carrier to bend, however it is not until removal of either of the stiffening elements that the carrier itself is allowed to “curve” (see Treaba column 7, lines 63-67 and column 8, lines 1-6).

Allowable Subject Matter

22. Claims 11-12 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

23. Claim 31 is allowed.

24. The indicated allowability of claim 30 is withdrawn in view of the newly discovered reference(s) to Application 10/149,643. Rejections based on the newly cited reference(s) follow.

Double Patenting

25. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

26. Claims 2, 4-6, 8-10, 13-18, 20-25, and 27-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 10/149,643. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are either an obvious broadening of the scope of the conflicting claims or an obvious variant thereof. Specifically, the Claims of Application No. 10/149,643 cover all aspects and all limitations of claims 2, 4-6, 8-10, 13-18, 20-25, and 27-30 in the current Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


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28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica L. Reidel whose telephone number is (571) 272-2129. The examiner can normally be reached on Mon-Thurs 8:00-5:30, every other Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jessica L. Reidel
Examiner
Art Unit 3766
05/09/06


Robert E. Pezzuto
Supervisory Patent Examiner
Art Unit 3766